

**Reprint
as at 1 April 2002**



**Patents (Patent Cooperation
Treaty) Regulations 1992**

(SR 1992/316)

Catherine A Tizard, Governor-General

Order in Council

At Wellington this 9th day of November 1992

Present:

The Right Hon D C McKinnon presiding in Council

Pursuant to section 114(1) and section 115 of the Patents Act 1953, Her Excellency the Governor-General, acting by and with the advice and consent of the Executive Council, hereby makes the following regulations.

Note

Changes authorised by section 17C of the Acts and Regulations Publication Act 1989 have been made in this reprint.

A general outline of these changes is set out in the notes at the end of this reprint, together with other explanatory material about this reprint.

These regulations are administered by the Ministry of Economic Development.

Contents

		Page
1	Title and commencement	2
2	Interpretation	2
	<i>Translation of documents forming part of Treaty application</i>	
3	English translation of documents as required	3
	<i>Time limits</i>	
4	Time limit specified for Articles 22(1) and 39(1) of Patent Cooperation Treaty	4
5	Time limit specified for section 26G(1)(b) of Act	5
6	Time restriction on when patent may be granted or refused	5
	<i>Additional information</i>	
7	Information to accompany Treaty application	5
8	Form and contents of Treaty application	6
	<i>Fees</i>	
9	Fees	6
10	Amount of goods and services tax not included	6
11	Transmittal fee	7
12	Basic fee and designation fee	7
13	Search fee	7
14	Late payment fee	7
15	Refund of fees	8
16	Trust Fund	8
	Schedule	9
	Fees	

Regulations

- 1 Title and commencement**
- (1) These regulations may be cited as the Patents (Patent Cooperation Treaty) Regulations 1992.
- (2) These regulations shall come into force on 1 December 1992.
- 2 Interpretation**
- In these regulations, unless the context otherwise requires,—
the Act means the Patents Act 1953

Article means an Article of the Patent Cooperation Treaty

certificate of verification means a statement—

- (a) that a document to which the statement relates is a true and complete translation of the accompanying document to the best of the knowledge of the person who signs the statement; and
- (b) that is dated and signed

Commissioner means the Commissioner of Patents

convention application has the same meaning as in the Act
international application, **International Bureau**, **Patent Cooperation Treaty**, **Treaty application**, and **Treaty regulations** have the same meanings as in the Act

national phase means the period of time in which a Treaty application is examined, considered, and processed by the Commissioner under the Act, which time shall commence, either—

- (a) following the fulfilment of the applicant's obligations under Article 22(1) of the Patent Cooperation Treaty; or
 - (b) following the fulfilment of the applicant's obligations under Article 39(1) of the Patent Cooperation Treaty—
- as the case may be

Patent Office Journal means the publication issued periodically by the Commissioner under section 112 of the Act

Rule means a Rule of the Treaty regulations.

Translation of documents forming part of Treaty application

3 English translation of documents as required

- (1) Subject to subclauses (2) to (4), where any document or documents forming part of a Treaty application have been supplied to the Commissioner in a language other than the English language, the applicant shall, within 3 months of the commencement date of the national phase, supply a translation of that document or documents, as the case may be, to the Commissioner, which translation shall be accompanied by a certificate of verification.
- (2) Upon application by the applicant in accordance with this regulation, the Commissioner may, for such time and upon

such terms as the Commissioner thinks fit, extend the time specified in subclause (1) for the supply of an English translation and certificate of verification.

- (3) The Commissioner may grant an extension pursuant to subclause (2) notwithstanding the fact that the time has expired for the supply of the English translation and certificate of verification.
- (4) An application for extension of time must be made in writing.
- (5) *[Revoked]*

Regulation 3(1): amended, on 1 January 2002, by regulation 3(1) of the Patents (Patent Cooperation Treaty) Amendment Regulations 2001 (SR 2001/357).

Regulation 3(1): amended, on 19 May 1994, by regulation 2(1) of the Patents (Patent Cooperation Treaty) Regulations 1992, Amendment No 1 (SR 1994/59).

Regulation 3(2): added, on 19 May 1994, by regulation 2(2) of the Patents (Patent Cooperation Treaty) Regulations 1992, Amendment No 1 (SR 1994/59).

Regulation 3(3): added, on 19 May 1994, by regulation 2(2) of the Patents (Patent Cooperation Treaty) Regulations 1992, Amendment No 1 (SR 1994/59).

Regulation 3(4): substituted, on 1 January 2002, by regulation 3(2) of the Patents (Patent Cooperation Treaty) Amendment Regulations 2001 (SR 2001/357).

Regulation 3(5): revoked, on 1 January 2002, by regulation 3(2) of the Patents (Patent Cooperation Treaty) Amendment Regulations 2001 (SR 2001/357).

Time limits

4 Time limit specified for Articles 22(1) and 39(1) of Patent Cooperation Treaty

- (1) Where New Zealand was, within the meaning of Article 31(4)(a) of the Patent Cooperation Treaty, indicated as an elected State for the purposes of an international application within the period of 19 months from the priority date accorded that application, the applicant shall fulfil the applicant's obligations under Article 39(1) of the Patent Cooperation Treaty within the period of 31 months from that priority date.
- (2) In any other case, the applicant of an international application shall fulfil the applicant's obligations under Article 22(1) of the Patent Cooperation Treaty within the period of 31 months from the priority date accorded that application.

Regulation 4(2): amended, on 1 April 2002, by regulation 3 of the Patents (Patent Cooperation Treaty) Amendment Regulations 2002 (SR 2002/42).

5 Time limit specified for section 26G(1)(b) of Act

For the purposes of section 26G(1)(b) of the Act the prescribed time limit shall be—

- (a) 31 months from the priority date accorded the international application, where New Zealand was, within the meaning of Article 31(4)(a) of the Patent Cooperation Treaty, indicated as an elected State for the purposes of that application within the period of 19 months from that priority date:
- (b) 31 months from the priority date accorded the international application, in any other case, to which paragraph (a) does not apply.

Regulation 5(b): amended, on 1 April 2002, by regulation 4 of the Patents (Patent Cooperation Treaty) Amendment Regulations 2002 (SR 2002/42).

6 Time restriction on when patent may be granted or refused

- (1) Subject to subclause (2), except on the express request of the applicant, the Commissioner shall not grant a patent or refuse to grant a patent, until the expiration of 1 month from the date on which the applicant has fulfilled the applicant's obligations under either Article 22(1) or Article 39(1) of the Patent Cooperation Treaty, as the case may be.
- (2) Where communication to the Commissioner in accordance with Rule 47.1 of the Treaty regulations has not been made within the period of 1 month from the date on which the applicant fulfilled the applicant's obligations under either Article 22(1) or Article 39(1) of the Patent Cooperation Treaty, as the case may be, the time limit set out in subclause (1) of this regulation shall be extended to 4 months.

Additional information

7 Information to accompany Treaty application

At any time during the national phase and before the expiration of the time period specified in section 19(1) of the Act for putting the application in order, the applicant of a Treaty application shall supply the Commissioner with the following information:

- (a) in the case of a convention application, a declaration as to the inventorship of the invention disclosed in the application:
- (b) in the case of an application other than a convention application, a declaration alleging the right of the applicant to make the application:
- (c) an address for service in New Zealand, which address shall be regarded for the purposes of the application as the applicant's address:
- (d) where applicable, a notice of authorisation appointing an agent to act for the applicant in any proceedings or matters before or affecting the Commissioner under the Act or these regulations concerning the Treaty application. In the case of any such appointment, service upon the agent of any document relating to the application shall be deemed to be service upon the person so appointing him or her, all communications directed to be made to the person in respect of the proceedings or matters may be addressed to the agent, and all attendances upon the Commissioner relating thereto may be made by or through the agent.

8 Form and contents of Treaty application

Notwithstanding the Patents Regulations 1954, the requirements relating to the form and contents of any Treaty application, shall be those set out in the Patent Cooperation Treaty, the Treaty regulations, and these regulations.

Fees

9 Fees

The fees payable to the Commissioner in respect of any international application are set out in the Schedule.

10 Amount of goods and services tax not included

The fees prescribed by these regulations are exclusive of goods and services tax under the Goods and Services Tax Act 1985.

11 Transmittal fee

An applicant shall pay a transmittal fee to the Commissioner, in accordance with Rule 14.1 of the Treaty regulations, within 1 month of the applicant filing the international application.

12 Basic fee and designation fee

- (1) The Commissioner shall, from time to time, by notice in the Patent Office Journal, publish the fees, to be collected by the Commissioner on behalf of the International Bureau, pursuant to Rule 15 of the Treaty regulations.
- (2) Any alteration in the amount payable pursuant to subclause (1) shall be published in the Patent Office Journal and shall take effect from the date prescribed under Rule 15.2(d) of the Treaty regulations.

13 Search fee

- (1) The Commissioner shall, from time to time, by notice in the Patent Office Journal, publish the fee to be collected by the Commissioner, on behalf of any International Searching Authority, pursuant to Rule 16 of the Treaty regulations.
- (2) Any alteration in the amount payable pursuant to subclause (1) shall be published in the Patent Office Journal and shall take effect from the date prescribed under Rule 16.1(d) of the Treaty regulations.

14 Late payment fee

- (1) Where a transmittal fee is payable by the applicant pursuant to Rule 14.1 of the Treaty regulations and the fee is not paid in accordance with the provisions of regulation 11 of these regulations the applicant shall pay to the Commissioner a late payment fee in accordance with Rule 16^{bis}.2 of the Patent Cooperation Treaty.
- (2) Where a basic fee or designation fee, payable by the applicant pursuant to Rule 15.1 of the Treaty regulations and in accordance with the provisions of regulation 12 of these regulations, is not paid within the time period prescribed for each fee pursuant to Rule 15.4 of the Treaty regulations, the applicant shall

pay to the Commissioner a late payment fee in accordance with Rule 16^{bis}.2 of the Patent Cooperation Treaty.

- (3) Where a search fee payable by the applicant pursuant to Rule 16 of the Treaty regulations and in accordance with the provisions of regulation 13 of these regulations, is not paid within the time period prescribed pursuant to Rule 16.1(f) of the Treaty regulations, the applicant shall pay to the Commissioner a late payment fee in accordance with Rule 16^{bis}.2 of the Patent Cooperation Treaty.
- (4) The amount of the late payment fee payable by the applicant pursuant to subclauses (1) to (3) shall be—
 - (a) 50% of the amount of the unpaid fee or fees, as the case may be, specified in the invitation made to the applicant under either Rule 16^{bis}.1(a) or 16^{bis}.1(b) of the Treaty regulations; or
 - (b) if the amount calculated under paragraph (a) of subclause (4) is less than the transmittal fee, an amount equal to the transmittal fee.
- (5) The late payment fee payable under this regulation shall not exceed the amount of the basic fee payable under these regulations.

15 Refund of fees

Where, in relation to a fee paid to the Commissioner, the Patent Cooperation Treaty requires that the fee be refunded to an applicant either in whole or in part, that fee or that part of that fee, as the case may be, shall be refunded by the Commissioner to the applicant accordingly.

16 Trust Fund

- (1) All fees collected by the Commissioner on behalf of the International Bureau or any International Searching Authority shall be paid into a Trust Fund established for the benefit of those organisations and administered in accordance with Part 7 of the Public Finance Act 1989.
- (2) The Commissioner acting as trustee of the Trust Fund established pursuant to subclause (1) may expend the monies held in trust for the purposes of the Patent Cooperation Treaty includ-

ing the refunds and the remission of fees to the International Bureau and any International Searching Authority.

Schedule

r 9

Fees

Schedule: substituted, on 1 July 1999, by regulation 2 of the Patents (Patent Cooperation Treaty) Amendment Regulations 1999 (SR 1999/156).

Matter	Fee (\$)
<i>The International Phase</i>	
Transmittal fee for each international application	180
<i>The National Phase</i>	
On entry into the national phase of a Treaty application for a patent	250

Marie Shroff,
Clerk of the Executive Council.

Contents

- 1 General
 - 2 Status of reprints
 - 3 How reprints are prepared
 - 4 Changes made under section 17C of the Acts and Regulations Publication Act 1989
 - 5 List of amendments incorporated in this reprint (most recent first)
-

Notes**1 General**

This is a reprint of the Patents (Patent Cooperation Treaty) Regulations 1992. The reprint incorporates all the amendments to the regulations as at 1 April 2002, as specified in the list of amendments at the end of these notes.

Relevant provisions of any amending enactments that contain transitional, savings, or application provisions that cannot be compiled in the reprint are also included, after the principal enactment, in chronological order. For more information, see <http://www.pco.parliament.govt.nz/reprints/>.

2 Status of reprints

Under section 16D of the Acts and Regulations Publication Act 1989, reprints are presumed to correctly state, as at the date of the reprint, the law enacted by the principal enactment and by the amendments to that enactment. This presumption applies even though editorial changes authorised by section 17C of the Acts and Regulations Publication Act 1989 have been made in the reprint.

This presumption may be rebutted by producing the official volumes of statutes or statutory regulations in which the principal enactment and its amendments are contained.

3 How reprints are prepared

A number of editorial conventions are followed in the preparation of reprints. For example, the enacting words are not included in Acts, and provisions that are repealed or revoked

are omitted. For a detailed list of the editorial conventions, see <http://www.pco.parliament.govt.nz/editorial-conventions/> or Part 8 of the *Tables of New Zealand Acts and Ordinances and Statutory Regulations and Deemed Regulations in Force*.

4 Changes made under section 17C of the Acts and Regulations Publication Act 1989

Section 17C of the Acts and Regulations Publication Act 1989 authorises the making of editorial changes in a reprint as set out in sections 17D and 17E of that Act so that, to the extent permitted, the format and style of the reprinted enactment is consistent with current legislative drafting practice. Changes that would alter the effect of the legislation are not permitted. A new format of legislation was introduced on 1 January 2000. Changes to legislative drafting style have also been made since 1997, and are ongoing. To the extent permitted by section 17C of the Acts and Regulations Publication Act 1989, all legislation reprinted after 1 January 2000 is in the new format for legislation and reflects current drafting practice at the time of the reprint.

In outline, the editorial changes made in reprints under the authority of section 17C of the Acts and Regulations Publication Act 1989 are set out below, and they have been applied, where relevant, in the preparation of this reprint:

- omission of unnecessary referential words (such as “of this section” and “of this Act”)
- typeface and type size (Times Roman, generally in 11.5 point)
- layout of provisions, including:
 - indentation
 - position of section headings (eg, the number and heading now appear above the section)
- format of definitions (eg, the defined term now appears in bold type, without quotation marks)
- format of dates (eg, a date formerly expressed as “the 1st day of January 1999” is now expressed as “1 January 1999”)

- position of the date of assent (it now appears on the front page of each Act)
- punctuation (eg, colons are not used after definitions)
- Parts numbered with roman numerals are replaced with arabic numerals, and all cross-references are changed accordingly
- case and appearance of letters and words, including:
 - format of headings (eg, headings where each word formerly appeared with an initial capital letter followed by small capital letters are amended so that the heading appears in bold, with only the first word (and any proper nouns) appearing with an initial capital letter)
 - small capital letters in section and subsection references are now capital letters
- schedules are renumbered (eg, Schedule 1 replaces First Schedule), and all cross-references are changed accordingly
- running heads (the information that appears at the top of each page)
- format of two-column schedules of consequential amendments, and schedules of repeals (eg, they are rearranged into alphabetical order, rather than chronological).

5 *List of amendments incorporated in this reprint (most recent first)*

Patents (Patent Cooperation Treaty) Amendment Regulations 2002 (SR 2002/42)

Patents (Patent Cooperation Treaty) Amendment Regulations 2001 (SR 2001/357)

Patents (Patent Cooperation Treaty) Amendment Regulations 1999 (SR 1999/156)

Patents (Patent Cooperation Treaty) Regulations 1992, Amendment No 1 (SR 1994/59)